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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,632	10/18/2001	David Wayne Bruner	DB01-01	8592
7590		08/11/2006	EXAMINER	
Angus C. Fox, III		BEKERMANN, MICHAEL		
4093 N. Imperial Way		ART UNIT		
Provo, UT 84604-5386		PAPER NUMBER		
		3622		

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/982,632	BRUNER, DAVID WAYNE	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/18/2001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 1, 8, 9, 16, 17, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 1, 8, 9, 16, 17, and 24, these claims recite the limitation "and/or". This is unclear, as this limitation should read "and" or "or", but not both.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 4-6, 9-13, 17, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (U.S. Patent No. 5,978,013).** Jones teaches a system and method for printing discount coupons that includes all of the limitations recited in the above claims.

Regarding claims 1, 9, 10, and 17, Jones teaches a searchable database of discount offers (Column 5, Lines 40-45) each having restrictions with regard to the

number of times a single consumer may take advantage (Column 2, Lines 54-57), establishing a pool of registered subscribing consumers (subscribers) (Column 4, Lines 32-38), providing sheets of security paper, and allowing each of the subscribers to download and print the coupons (Column 16, Lines 31-42).

Regarding claims 4, 11, and 20, Jones teaches a step of calibrating the coupon to be printed by the printer (Column 9, Lines 52-54). The step of calibrating the way the image will look when printed is taken to be printer calibration.

Regarding claims 5, 6, 12, 13, 21 and 22, Jones teaches the coupon including consumer identifying tracking information (demographic information bar-code) and a unique serial number (UPC bar-code) (Column 10, Lines 25-29).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 2 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. Patent No. 5,978,013) in view of Enomoto (U.S. Patent No. 6,026,435).**

Regarding claims 2 and 18, Jones teaches distributing coupons from a server computer over a television network. Jones does not specify the distribution as occurring over the Internet. Enomoto teaches television that is operated over the Internet (Figure

2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to register those customers that use Internet television as well as those who don't in the interest of broadening the customer base.

Claims 3, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. Patent No. 5,978,013).

Regarding claims 3, 15, and 19, Jones teaches that the user must tear the coupon to free it once it has been printed (Column 10, Lines 29-30). Jones does not specify any method to aid the user in performing this step. Official notice is taken that perforated tear lines are old and well-known. Raffle and movie tickets have been using this tearing device for years. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include perforated tear lines on the security paper to help the customer tear the coupons.

Claims 7, 14, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. Patent No. 5,978,013) in view of Engel (U.S. Patent No. 5,907,830).

Regarding claims 7, 14, and 23, Jones does not specify statistical tracking of the coupons. Engel teaches tracking coupon redemption and determining consumer buying habits based from this data (Column 3, Lines 1-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to track this

sort of information in the interest of learning more about what customers like and using this information to earn greater profit.

Claims 8, 16, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. Patent No. 5,978,013) in view of O'Hagan (U.S. Patent No. 6,314,406).

Regarding claims 8, 16, and 24, Jones does not specify lesser discounts for fewer restrictions. O'Hagan teaches a coupon that has less of a discount, but a longer period in which it may be redeemed (Column 23, Lines 9-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to offer dynamic coupon restrictions in the interest of catering to different types of customers and broadening the market.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. Patent No. 5,978,013) in view of McMahon (U.S. Patent No. 5,789,732).

Regarding claim 25, Jones teaches a user being limited to printing a coupon only once in a predetermined time period (Column 14, Lines 56-58). Jones also teaches only generating a coupon during a coupon availability window (Column 5, Lines 47-49). Jones does not teach giving rainchecks for coupons that are not available for printing. McMahon teaches automatically giving rainchecks for items that are unavailable at that current time (Column 2, Lines 40-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to give customers rainchecks

if a coupon is not available (not during the availability window). This would allow more customers to take advantage of the discount while driving sales for the advertised product up.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to searching for and printing discount offers:

U.S. Patent No. 7,010,498 to Berstis

U.S. Pub No. 2004/0056101 to Barkan

U.S. Pub No. 2002/0077892 to Goring

U.S. Pub No. 2002/0194069 to Thakur


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JEFFREY D. CARLSON
PRIMARY EXAMINER